

PATENT

Atty. Dkt. No. ROC920000014US1

REMARKS

This is intended as a full and complete response to the Final Office Action dated June 10, 2004, having a shortened statutory period for response set to expire on September 10, 2004. Applicants submit this amendment to place the application in condition for allowance or in better form for appeal. Please reconsider the claims pending in the application for reasons discussed below.

Claims 1-4, 6-13, 15-22, 24-30 are pending in the application. Claims 3-4, 6-9, 12-13, 15-18, 21-22, 24-33 remain pending following entry of this response. Claims 3, 4, 6, 8, 12, 13, 15, 17, 21, 22, 24, 26 and 28-30 have been amended. Claims 1-2, 10-11 and 19-20 have been cancelled. Claims 31-33 have been added as replacements of canceled claims 2, 11, and 20, respectively, with corrected dependencies to independent claims 3, 12 and 21.

Claims 1-3, 10-12 and 19-21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Damerau et al.* (US 5,258,909) in view of *McRae et al.* (US 4,847,766) and *Fein et al.* (US 5,940,847). Claims 1-2, 10-11, and 19-20 have been cancelled. Claims 3, 12 and 21 have been amended to incorporate features previously presented in independent claims 1, 10 and 19, respectively. Claims 2, 11 and 20 are presented again with corrected dependencies in new claims 31-33. Applicants respectfully traverse this rejection.

The Examiner again takes the position that it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have stored and compared the pre-edited and post-edited content to identify the problem words and replacement words because those would have been the only words different between the two document versions. In response to Applicants' previous arguments, the Examiner further takes the position that one of ordinary skill in the art at the time of the invention without hindsight knowledge of the claimed invention would have been motivated to have created a history to have identified the problem words and their replacements by the means of the claim invention or some other equally effective means.

Applicants traverse the rejection on grounds that the Examiner still has not properly established a prima facie obviousness rejection because the cited references

Page 8

290399_1

fail to teach or suggest all the claim limitations. *Damerau et al.* and *McRae et al.* have been discussed previously. Newly cited reference *Fein et al.* discloses a system and method for automatically correcting multi-word data entry errors. The cited references, alone or in combination, fail to teach, show or suggest the steps of recording the pre-edited content and the post-edited content and comparing the pre-edited content to the post-edited content to identify the problem words and replacement words, as recited in claims 3, 12 and 21.

Furthermore, M.P.E.P. §2143.01 expressly states that the fact that a claimed invention might be within the capability of one of ordinary skill in the art is not sufficient to establish obviousness. See, *Ex Parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993) and *In re Kotzab*, 55 USPQ2d 1313, (Fed. Cir 2000). Applicant submits that an unsupported conclusion that one of ordinary skill in the art could have envisioned the claimed invention constitutes no more than impermissible hindsight reconstruction of Applicant's invention. See, *In Re Dembiczak*, 50 USPQ2d 1614 (Fed. Cir. 1999). Applicants submit that the references cited by the Examiner, either alone or in combination, fail to provide any motivation to record the pre-edited contents and post edited contents and/or to create a history record of the modifications and respectfully submits that the Examiner has applied improper hindsight in concluding that one would have been motivated to have created such a history. Therefore, Applicants submit that claims 3, 12 and 21, and the claims depending therefrom, are patentable over *Damerau et al.* in view of *McRae et al.* and *Fein et al.*, and reconsideration of the rejection is respectfully requested.

Claims 4, 13 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Damerau et al.* in view of *McRae et al.* and *Fein et al.*, as applied to claims 3, 12 and 21 above, and further in view of *Lange et al.* (US 4,674,065). Applicants respectfully traverse the rejection and respectfully submit that the cited references, alone or in combination, fail to teach, show, or suggest the limitations recited in claims 4, 13 and 22. The cited references, alone or in combination, fail to teach, show, or suggest separately storing the pre-edited contents and post-edited contents to a second data structure. Furthermore, the cited references, alone or in combination, fail to teach, show, or suggest that the second data structure include a

pre-edited word field, a post-edited word field and a changed indication field. Although the references cited by the Examiner disclose various methods for correcting spelling errors which include some sort of dictionary or correction list, the references cited by the Examiner, alone or in combination, do not teach, show or suggest storing the pre-edited content and the post-edited content in a document in the data structure as recited in claims 4, 13 and 22. Therefore, Applicants submit that claims 4, 13 and 22 are patentable over *Damerau et al.* in view of *McRae et al.*, and further in view of *Lange et al.*, and reconsideration of the rejection is respectfully requested.

Claims 6-7, 15-16 and 24-25 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Damerau et al.* in view of *McRae et al.* and *Fein et al.* as applied to claims 1, 10 and 19 above, and further in view of *Grover et al.* (US 5,818,437). As discussed above, the cited references, alone or in combination, fail to teach, show or suggest the steps of recording the pre-edited content and the post-edited content and comparing the pre-edited content to the post-edited content to identify the problem words and replacement words, as recited in independent claims 3, 12 and 21. Furthermore, the references cited by the Examiner, alone or in combination, do not teach, show or suggest storing the pre-edited content and the post-edited content in a document in the data structure as recited in claims 4, 13 and 22. Therefore, Applicants submit that claims 6-7, 15-16 and 24-25 are patentable over *Damerau et al.* in view of *McRae et al.* and *Fein et al.*, and further in view of *Grover et al.*

Claims 8-9, 17-18 and 26-27 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Damerau et al.* in view of *McRae et al.* and *Fein et al.* as applied to claims 1, 10 and 19 above, and further in view of *Cai et al.* (US 6,175,834). As discussed above, the cited references, alone or in combination, fail to teach, show or suggest the steps of recording the pre-edited content and the post-edited content and comparing the pre-edited content to the post-edited content to identify the problem words and replacement words, as recited in independent claims 3, 12 and 21. Therefore, Applicants submit that claims 8-9, 17-18 and 26-27 are patentable over *Damerau et al.* in view of *McRae et al.* and *Fein et al.*, and further in view of *Cai et al.*

The secondary references made of record are noted. However, it is believed that the secondary references are no more pertinent to the Applicants' disclosure than the

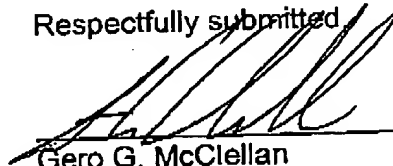
PATENT

Atty. Dkt. No. ROC920000014US1

primary references cited in the Final Office Action. Therefore, Applicants believe that a detailed discussion of the secondary references is not necessary for a full and complete response to this Final Office Action.

Having addressed all issues set out in the office action, Applicants respectfully submit that the claims are in condition for allowance and respectfully request that the claims be allowed.

Respectfully submitted



Gero G. McClellan

Registration No. 44,227

MOSER, PATTERSON & SHERIDAN, L.L.P.

3040 Post Oak Blvd. Suite 1500

Houston, TX 77056

Telephone: (713) 623-4844

Facsimile: (713) 623-4846

Attorney for Applicant(s)